

## REMARKS

The Office Action mailed August 6, 2008, has been received and carefully considered. Claims 1-28 stand rejected. Upon entry of the present amendment, claims 1-10, 12-21, and 23-30 will be pending. As of the Office Action, claims 1-5, 7-8 and 12-28 stand rejected as anticipated under 35 U.S.C. §102(b) by U.S. Patent 6,254,954 to Bennett et al. (Bennett) and claims 1-5 and 8 stand rejected as anticipated under 35 U.S.C. 102(e) by U.S. Publication 2003/0040550 to Ishizawa et al. (Ishizawa). Claims 1-5, 7-9 and 11 stand rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative, as obvious under 35 U.S.C. §103(a) in view of U.S. Patent 6,235,850 to Perez. Claims 6-7 and 10 stand rejected under 35 U.S.C. §103(a) as obvious over Bennett in view of U.S. Publication 2004/0225025 to Sullivan et al. (Sullivan). The rejections are respectfully traversed and reconsideration is respectfully requested.

### **I. Amendments to the Claims.**

Claims 1 and 12-17 are amended to exclude polyesters and acrylates. Corresponding amendments are also made to claims 2 and 23 and by cancelling claims 11 and 22. New claims 29 and 30 are added. Support for amendments and new claims can be found at least at paras. [0026]-[0029] and throughout the Application as originally filed. No new matter is presented.

### **II. Rejections under 35 U.S.C. § 102.**

It is well established that to anticipate a claimed invention, a reference must teach each and every element of the claimed invention, either explicitly or inherently. *In re Schreiber*, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Thus, identifying a single element of the claim, which is not disclosed in the reference, is sufficient to overcome a §102 rejection.

Claims 1-5, 7-8 and 12-21 and 23-28 stand rejected as anticipated by Bennett; claims 1-5 and 8 stand rejected as anticipated by Ishizawa; and claims 1-5 and 7-9 stand rejected as anticipated by Perez, or alternatively as obvious in view of Perez. The rejections are respectfully traversed.

As understood by Applicants, each of Bennett and Ishizawa are directed to adhesives in which the polymer component is a polyester (see, e.g. Bennett and Ishizawa abstracts). As also understood by Applicants, Perez is directed solely to epoxy/acrylic systems and in which all of the components are terpolymers. With respect to independent claim 1, as amended, Applicants' claimed invention now excludes polyesters and acrylates from the polymer present in about 15 to about 80% by weight and having a softening point greater than 60°C and for at least this reason, the cited references cannot anticipate the claimed invention and the rejection should be withdrawn.

Additionally, Bennett and Ishizawa also fail to specifically disclose that a resin present in an amount from about 20 to about 85% by weight having a softening point less than 30°C should be used in combination with the polymer present in about 15 to about 80% by weight and having a softening point greater than 60°C. While the references disclose some resins that happen to have a softening point lower than 30°C that are used in combination with certain polyesters, there is no teaching or fair suggestion in either of these two references of any connection or importance associated with the softening temperature of the polymer versus that of the resin as was discovered by Applicants, much less of any of the advantages achieved thereby.

Likewise, with respect to Perez, the Examiner admits that Perez fails to teach softening points of the terpolymer components. Office Action at 5. The Examiner states, without citation to the MPEP or other supporting authority that the burden shifts to Applicant to show the

claimed invention is not obvious. As previously discussed, acrylates have now been excluded from Applicants claimed invention.

In any event, Applicants have in fact pointed out numerous advantages achieved by the claimed invention relating to the softening points of the polymer and resin components of the composition, including reduced shrinkage (see Application, e.g., para. [0025]) and ability to use the adhesive in low temperature applications (see Application, e.g., paras. [0024],[0051]) which can be contrasted, for example, with Bennett which teaches that substrates to which the adhesive is to be applied should be heated to between 40 to 140°C, with a preferred heating range of 80 to 120°C. Bennett 13:11-24.

Claims 2-5 and 7-9 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable.

With respect to independent claims 12-17, rejected only over Bennett, these claims have all been amended to incorporate the same compositional limitations as found in claim 1. Thus, these claims are believed to be allowable for at least the same reasons that claim 1 was shown above to be allowable. Applicants respectfully submit that the rejections are based merely on Bennett's reference to an ultimate use without considering the structural limitations also found in those claims. Thus, Bennett further fails to teach each and every limitation of the claimed invention and the rejection should be withdrawn for these additional reasons. Furthermore, as discussed above, Bennett teaches that substrates to which the composition is applied should first be heated to temperatures that are preferably in excess of 80°C suggesting (1) that Bennett's composition would not in fact be suitable for application to the temperature sensitive devices of claims 12-17 and (2) that because such heat activation is apparently necessary, despite the

terminology used by Bennett, those of ordinary skill would not consider Bennett's composition to be a pressure sensitive adhesive, but rather a heat sealable adhesive.

Claims 18-21 and 23-28 depend from claims 12-17 are allowable for at least the reasons that claims 12-17 are allowable.

Thus the rejections should be withdrawn and the claims allowed.

**III. Rejection under 35 U.S.C. § 103(a).**

Claims 6-7 and 10 stand rejected over Bennett in view of Sullivan. The rejection is respectfully traversed. Claims 6, 7 and 10 each depend from claim 1, shown above to be allowable. Sullivan is cited only for its teachings related to additives and fails to overcome deficiencies of Bennett identified above. Thus, the rejection should be withdrawn and the claims allowed.

**IV. New Claims 29-30.**

New claims 29 and 30 depend from claim 1 and are allowable for at least the reason that claim 1 was shown above to be allowable.

### CONCLUSION

Accordingly, for at least these reasons, Applicants respectfully request that the Application be allowed and passed to issue. In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve such issues in an expeditious manner.

This Amendment/Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct this and any other fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: October 31, 2008

Respectfully submitted,

MCNEES WALLACE & NURICK LLC  
Attorneys for Applicants

By:

/Shawn K. Leppo/

Shawn K. Leppo, Reg. No. 50,311  
P.O. Box 1166  
100 Pine Street  
Harrisburg, Pennsylvania 17108  
Direct Dial: (717) 237-5218  
Facsimile: (717) 260-1718